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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/816,968

04/02/2004

Masashi Ogawa

JG-SIK-5112D

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06/30/2006

REED SMITH, LLP

ATTN: PATENT RECORDS DEPARTMENT
599 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022-7650

EXAMINER

FERNANDEZ, SUSAN EMILY

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/816,968

Applicant(s)

OGAWA ET AL.

Examiner

Susan E. Fernandez

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/045,539.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

The preliminary amendment filed April 2, 2004, has been received and entered.

Claims 1-10 are cancelled. Claims 11-13 are pending and examined on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 is indefinite since it is unclear whether “a colored film having a thickness of 3 to 6 μm is located on one side of a support” are structural limitations of the device. It appears that claim 11 should read as “A device for cutting a biological sample comprising a colored film...,” and for examination purposes, it will be interpreted this way. Additionally, it is unclear how the “support” relates to the purpose of the device. It appears that the support is a support for holding the biological sample. Claims 11-13 are thus rejected under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baer et al. (US 5,985,085) in view of Schutze et al. (Nature Biotechnology. 1988. 16: 737-742).

Baer et al. discloses a "...laser capture microdissection apparatus, comprising: a transfer film carrier having a substrate surface; and a laser capture microdissection transfer film coupled to said substrate surface of said transfer film carrier..." (column 3, lines 41-46). Thus, a device for cutting a biological sample is disclosed comprising a film located on one side of a support. It is noted that the film can be considered a "colored film" since the transfer film is manufactured containing organic dyes which selectively absorb certain wavelengths (column 2, lines 37-39). Additionally, the substrate surface included in the device, which is the support, is a plate that can be fabricated from glass (column 5, lines 51-52). As shown on Figures 5A and 5C, the transfer film is located on one side of the substrate surface.

Baer et al. does not expressly disclose that the thickness of the transfer film is in the range of from 3 to 6 μm located on one side of the support.

However, Baer et al. indicates that: "it is advantageous that the LCM transfer film 400 be thin. For example, a 50 micron thick film is preferable to a 100 micron thick film. However, the film can advantageously be fabricated in thicknesses of approximately 500, 400, 300, 200, 100, 50 microns **or less**" (column 6, lines 32-37, emphasis added).

Thus, although Baer et al. does not explicitly disclose the claimed film thickness range, Baer clearly discloses the desirability of using thin films. The artisan of ordinary skill would therefore have been motivated to have employed a film having the claimed thickness in the process disclosed by Baer et al. Moreover, Schutze et al. discloses laser microbeam microdissection as well. As in Baer et al., Schutze et al. teaches the placement of a transfer film (polyethylene membrane) on a surface (glass slide). See page 738, particularly Figure 1. The thickness of the transfer film in the device disclosed in Schutze et al. is 1.35 μm (Figure 1). Therefore, one of ordinary skill in the art would have been motivated to have used transfer film thicknesses such as those recited since the prior art had shown that even a thickness as low as 1.35 μm would have been appropriate for laser microbeam microdissection.

Lastly, the determination of a suitable polymer film, such as the aramid recited in claim 13, must be considered obvious in view of Baer's disclosure that a wide variety of polymeric films are suitable in the processes disclosed therein. See column 8, lines 33-42. A holding of obviousness is clearly required.

No claims are allowed.

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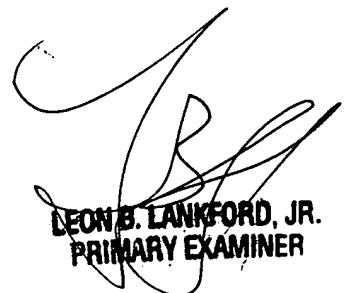
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan E. Fernandez whose telephone number is (571) 272-3444. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Susan E. Fernandez
Assistant Examiner
Art Unit 1651

sef



LEON B. LANKFORD, JR.
PRIMARY EXAMINER